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Application Number

10/687,728

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10/16/2003

First Named Inventor

HWANG, Kuen-Yih

Art Unit

2617

Examiner Name

MILLER, Brandon

Attorney Docket Number

P3108

ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Intrado Inc.		
Signature	/Michael B. Johannesen/		
Printed name	Michael B. Johannesen		
Date	November 21, 2006	Reg. No.	35,557

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit: 2617
)	
HWANG, Kuen-Yih, <i>et al.</i>)	Examiner: MILLER, Brandon
)	
Serial No.: 10/687,728)	
)	
Confirmation No.: 4892)	
)	
Filed: 10/16/2003)	
)	
Atty. Docket No.: 4380-5)	
)	
Title: "Location Caller)	
Identification Information Method)	
and Apparatus")	

Clerk of the Board
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

I. Real Party in Interest

The Real Party in Interest is Intrado, Inc.

II. Related Appeals and Interferences

There no related appeals and interferences.

III. Status of Claims

Claims 1 – 49 were originally presented. Claims 32 – 45 were cancelled and claims 50 – 61 were added by Applicant's Amendment dated February 7, 2006. Claims 8 – 31 and 46 – 49 were cancelled by entry of Applicants' Amendment After Final dated June 19, 2006.

Thus, Claims 1 – 7 and 50 – 61 are pending in this Appeal.

Claim 1 – 7 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Publication Number 2002/0102989 A1 to Calvert *et al.* (herein “*Calvert*”) in view of U.S. Patent Publication Number 2003/0035544 to Herle *et al.* (herein “*Herle*”); **Claims 50, 52, 54 – 55, 57 and 59 – 61** stand rejected under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of U.S. Patent Number 6,049,718 to Stewart (herein “*Stewart*”); **Claims 51 and 53** stands rejected under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of *Herle* and further in view of *Stewart*; and **Claims 56 and 58** stand rejected under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of *Stewart* and further in view of U.S. Patent Number 6,665,611 to Oran *et al.* (herein “*Oran*”).

IV. Status of Amendments

All amendments, which comprise an Amendment after Non-Final Office action filed February 7, 2006 and an Amendment after Final filed June 19, 2006, have been entered.

V. Summary of the Invention

This invention is generally directed to a system that provides communication device location information. (FIG.’s 1 and 5, paragraphs [0022] and [0044]) This system includes a first communication device and a second communication device. (FIG.’s 1 and 5, paragraphs [0023] and [0044]) The system also includes a communication network that interconnects the first and second communication devices. (FIG. 1, element 112, paragraphs [0024] through [0026]) The system further includes a location service center node connected to the communication network. (FIG. 1, element 132, paragraphs [0027] through [0029])

The location service center node receives a request for location-related information from a requesting one of the first and second communication devices regarding either one of the first and second communication devices. (FIG. 5, paragraph [0045]) The location service center node validates that the request is permissible. (FIG. 5, paragraphs [0051] and

[0052]) The location service center node then delivers location related information to the requesting one of the first and second communication devices. (FIG. 5, paragraph [0059])

This invention is also generally directed towards a method for providing location caller identification information. (FIG. 6, paragraph [0055]) The method includes initiating a call from a first communication device to a second communication device through a communication network. (FIG. 6, paragraphs [0057] and [0058]) The method further includes determining a location of the first communication device by a location service network node responsive to the call initiation. (FIG. 6, paragraph [0059]) Finally, the method includes delivering a call set up signal to the second communication device, wherein the call set up signal including the location of the first communication device. (FIG. 6, paragraph [0062])

VI. Issues

A. Are claims 1 – 7 unpatentable under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of *Herle*?

B. Are claims 50 – 61 unpatentable under 35 U.S.C. §103(a) as being obvious over *Calvert* in view of *Stewart*?

VII. Grouping of Claims

The rejected claims stand or fall together. Therefore, the claims are divided into the following groups:

A. Claims 1 – 7 stand or fall together.

B. Claims 50 – 61 stand or fall together.

VIII. Arguments

For the Examiner to establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, the Federal Circuit states that “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established law that “[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

A. Claims 1 – 7 are Patentable because (i) the art of record does not teach or suggest Applicants’ location service center node as defined in Claim 1 and (ii) the art of record does not suggest that the art can be combined successfully.

Applicants respectfully assert that *Calvert* and *Herle* do not teach or suggest the functionality of all of the elements of Applicants’ invention. Applicants also respectfully assert that there is no teaching or suggestion in either *Calvert* or *Herle* that it is desirable to combine the two references.

(i) Neither Calvert nor Herle teach or suggest Applicants’ location service center node.

Specifically, neither *Calvert* nor *Herle*, taken alone or together, teach or suggest the element of:

a location service center node connected to said communication network and

- (1.) configured to receive a request for location related information from a requesting one of said first and second communication devices regarding either one of said first and second communication devices,
- (2.) configured to validate that said request is permissible and
- (3.) configured to deliver said location related information to said requesting one of said first and second communication devices.

(Claim 1, lines 6 – 11, paragraphing and element numbering added for clarity and discussion purposes).

In his rejection, the Examiner asserts that Calvert teaches

a location service center node connected to the communications network (see paragraphs [0022] & [0026]) and configured to receive a request for location related information from a requesting one of the first and second communication devices regarding either one of the first and second communication devices (see paragraphs [0020] & [0034]).

Final Office Action, Page 3, last paragraph.

In discussing the above-cited limitation, it is important to note that Applicants' Claim 1 recites first and second communications devices. *Calvert* discusses three communications devices: a "particular device," a "requesting device" and a "target device." The "particular device" is the device to be located. The "requesting device" is the device making the request for location. The "target device" is the device to which the location information is delivered. *Calvert*, paragraph [0020].

Calvert teaches that, when a "requesting device" requests location information regarding a "particular device," the "target device" may also be the "requesting device." *Calvert*, paragraph [0034]. *Calvert* also teaches that when the "requesting device" is also the "particular device," the "target device" is another communications device. *Calvert*, paragraph [0034]. *Calvert* does not teach or suggest that the "particular device," the "requesting device" and the "target device" may all be the same device.

Thus, *Calvert* cannot not teach element (1.) above. *Calvert* is not configured to "receive a request for location related information from a requesting one of said first and second communication devices regarding either one of said first and second communication devices" because *Calvert* teaches a first device requesting information regarding a second

device (a “requesting device” regarding a “target device”) or sending location information manually input from a first device to a second device unsolicited (a “particular device” to a “target device”). *Calvert* does not clearly teach that the request may be reciprocal.

However, *Calvert* clearly does not teach or suggest that a device may request location information regarding itself. This argument is further strengthened by *Calvert*’s teaching that, when the “requesting device” is also the “particular device,” the user may bypass interaction with the infrastructure and just manually enter and send location information to the “target device.” *Calvert*, paragraph [0036].

For the same reason, *Calvert* does not teach or suggest element (3.) above. The system of *Calvert* may be thought of as a “one-way street.” *Calvert* teaches delivering manually entered location information to a “target device,” which is never referred to in *Calvert* as being the “particular device.” It is contradictory to assert that manually-entered location information in *Calvert* would be sent back to the same device. *Calvert*’s system never answers the question “where am I?” because it is the user himself or herself that determines the location and enters it manually. Applicants’ invention, as claimed in claim 1, and specifically elements (1.) and (3.) above, can answer the question “where am I?”

(ii) *There is no teaching or suggestion in either Calvert or Herle that these references can be combined.*

As to element (2.), above, Applicants agree with the Examiner that validating the location request is not found in *Calvert*. Applicants respectfully assert, however, that filing in this gap with the teaching of *Herle* is erroneous. There is no teaching or suggestion in either *Calvert* or *Herle* that it would be desirable to combine the two references. *Calvert* specifically teaches determining locations of communications devices by *asking the user* of the device where he or she is. It is likely that *Calvert* is silent about validation because *Calvert* specifically asks the user of the communications device where he or she is. Any response to the request provides sufficient validation.

In contrast, *Herle* automatically tracks a mobile station and records the location on an Internet-based mobile station location server. A problem in *Herle* is that the user of the mobile station is not necessarily aware of the location request. Further, any client access

device connected to the Internet can access the mobile station location server. Therefore, the location request must be validated to prevent unauthorized location requests. Such validation is not required in *Calvert* because the user is entering the location information. The problems being solved by the two references are opposites of each other: *Calvert* teaches a system that effectively says “here I am” and *Herle* teaches a system that effectively says “where are you?”

Thus, there is no motivation for combining *Calvert* with *Herle*. It is respectfully submitted that the only way one skilled in the art would combine these two references is to use Applicants’ claims as a “roadmap.” Therefore, Applicants’ independent Claim 1 is patentable because there is no common problem or expectation of success in the combination of reference. Claims 2 – 7 depend from allowable claim 1 and are therefore likewise allowable.

B. Applicants’ Claim 50 is patentable because the Examiner has not made a prima facie showing of obviousness.

Claims 50 – 61 stand rejected under 35 U.S.C. §103(a) as being obvious under *Calvert* in view of *Stewart* and, for some of the dependent Claims in this group, *Calvert* in view of *Stewart* and *Herle* or *Oran*. Applicants respectfully assert that the Examiner erred in his rejection of these claims because not all of the elements of claim 50 can be found in the cited art.

Specifically, neither *Calvert* nor *Stewart* teach or suggest Applicants’ claim element of

delivering a call set up signal to said second communication device, said call set up signal including the location of the first communication device.

Claim 50, lines 7 and 8.

The Examiner relies on *Stewart* for the proposition that “Stewart teaches delivering a call setup signal to the second communication device, the call set up signal including information from the first communication device (see col. 4, lines 8 – 15).” Final Office action, page 9, lines 14 – 16.

It is respectfully submitted that this is an incorrect interpretation of the cited passage in *Stewart*. In the cited paragraph, *Stewart* states:

The incoming call, in particular the incoming call data in the form of an incoming location request code and optionally a re-location request code, is then transmitted (210) to the called portable telephone 28.

Stewart, co. 4, lines 8 – 15 (emphasis added).

The “data” in *Stewart*’s incoming call is a “location request code” and/or a “re-location request code.” The “data” sent in the call setup signal in *Stewart* is not is location information, it is a request for location information. *Stewart* specifically teaches that the “location request code” is a code that requests the called telephone to transmit its location (derived from an internal GPS receiver). *Stewart*, Col. 4, lines 24 – 44. Thus, in *Stewart*, location information is actually delivered about the called telephone to the calling telephone. Applicants’ claimed invention specifically recites delivering location information about the calling telephone to the called telephone. The Examiner is erroneously equating requesting location information with location information itself, which are two different problems to be solved. Therefore, this rejection cannot stand because there is no *prima facie* showing of obviousness.

Claims 51 – 61 depend from allowable claim 50 and are likewise allowable.

IX. Conclusion

For the above-stated reasons, Applicants' Claims 1 – 7 and 50 – 61 are patentable. The Examiner has incorrectly rejected the claims as being obvious over *Calvert* in view of *Herle* (Claims 1 – 7) and *Calvert* in view of *Stewart* (Claims 50 – 61). The Examiner has failed to meet the requirement of establishing a prima facie rejection of the claims. At least one of the claim elements in each of the independent claims is not described, expressly or inherently, in any of the references taken alone or together. Further, the Examiner has not shown the motivation and expectation of success for combining *Calvert* and *Herle*. For these reasons, Applicants request that the Board reverse the Examiner's rejections of the pending claims.

Respectfully submitted,

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APPENDIX A – Pending Claims

1 1. A system for providing communication device location information, comprising:
2 a first communication device;
3 a second communication device;
4 a communication network configured to interconnect said first communication device
5 and said second communication device; and
6 a location service center node connected to said communication network and
7 configured to receive a request for location related information from a requesting one of said
8 first and second communication devices regarding either one of said first and second
9 communication devices, configured to validate that said request is permissible and
10 configured to deliver said location related information to said requesting one of said first and
11 second communication devices.

1 2. The system of Claim 1, wherein said validation request is made by a subscriber to a
2 location determining service.

1 3. The system of Claim 1, wherein said validation request is made by a network
2 node.

1 4. The system of Claim 1, wherein said communication network comprises a
2 plurality of communication networks.

1 5. The system of Claim 4, wherein said first communication device is associated with
2 a first network and said second one of said first and second communication devices is
3 associated with any one of said plurality of communication networks.

1 6. The system of Claim 1, wherein said location service center node is in
2 communication with a location determining entity separate from said first and second
3 communication devices.

1 7. The system of Claim 1, wherein said second one of said first and second
2 communication devices comprises a wireless telephone.

1 50. A method for providing location caller identification information comprising:
2 initiating a call from a first communication device to a second communication device
3 through a communication network;
4 determining a location of said first communication device by a location service
5 network node in communication with said communication network responsive to said
6 initiating; and
7 delivering a call set up signal to said second communication device, said call set up
8 signal including the location of the first communication device.

1 51. A method in accordance with claim 50 further including:

2 verifying that said second communication device is authorized to receive the location
3 of the first communication device.

1 52. A method in accordance with claim 50 further comprising:
2 determining a location of said second communication device at a location service
3 network node responsive to said initiating; and
4 delivering the location of the second communication device to the first
5 communication device.

1 53. A method in accordance with claim 52 further comprising:
2 verifying that said first communication device is authorized to receive the location of
3 the second communication device.

1 54. A method in accordance with claim 50 wherein determining a location of said
2 first communication device comprises:
3 contacting a location determining entity associated with said communication network.

1 55. (Previously Presented) A method in accordance with claim 54 wherein
2 determining a location of said first communication device comprises:
3 contacting a plurality of location determining entities.

1 56. A method in accordance with claim 54 wherein determining a location of said
2 first communication device comprises:

3 contacting an automatic location information (ALI) database.

1 57. A method in accordance with claim 54 wherein determining a location of said
2 first communication device comprises:

3 contacting a mobile positioning center.

1 58. (Previously Presented) A method in accordance with claim 54 wherein
2 determining a location of said first communication device comprises:

3 contacting a VoIP positioning center.

1 59. (Previously Presented) A method in accordance with claim 54 wherein
2 determining a location of said first communication device comprising:

3 determining the location of the first communication device at the time the call is
4 initiated.

1 60. A method in accordance with claim 50 wherein said communication network
2 comprises a plurality of communication networks and wherein said first communication
3 device and said location service node are in communication with a first of said plurality of
4 communication networks and said second communication device is in communication with a
5 second of said plurality of communication networks, the method further comprising:

6 delivering the location of the first communication device to the second
7 communication network.

1 61. A method in accordance with claim 60 wherein a further location node is in
2 communication with said second communication network, the method further comprising:
3 determining a location of said second communication device at said further location
4 node responsive to said call initiation; and
5 delivering the location of the second communication device to the first
6 communication device via said first communication network.